

**REMARKS**

Reconsideration is respectfully requested.

- Claims 1-4, 6-7, 9, 11-16 and 18-20 are pending. Claims 5, 8, 10 and 17  
5 have been canceled. Claims 1, 9 and 16 have been amended. Claim 5 was  
canceled because it is identical in subject matter to claim 2. The subject mat-  
ter of claims 8, 10 and 17 has been incorporated into amended claims 1, 9  
and 16 respectively.
- 10 Claims 1-8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over  
Nakano et al.
- Furthermore, claims 1, 3 and 4 stand rejected under 35 U.S.C. 103(a) as be-  
ing unpatentable over Nakano et al. further in view of Shih et al. or applicants'  
15 admissions at [0014] of the specification.
- Also, claims 1-8 stand rejected under 35 U.S.C. 103(a) as being unpatentable  
over Nakano et al. in view of Kaneko et al.
- 20 Additionally, claims 1-8 stand rejected under 35 U.S.C. 103(a) as being un-  
patentable over applicants' admissions in their 131 Declaration.

- As presently claimed, the present invention relates to a print medium comprising:
- 25 an ink-receiving layer and a coated, absorptive paperbase selected  
from the group consisting of coated, calendered paper; coated, uncalendered  
paper and cast coated paper; the ink-receiving layer being present on the  
coated paperbase from about 3 grams per square meter to about 7 grams per  
square meter, and the coated paperbase having a Sheffield smoothness less  
30 than approximately 20 and a Sheffield porosity less than approximately 10.

The present invention therefore relates to a new combination of a base paper and an ink receptive coating on the base paper. In the explanations of the rejections in the current office action, the examiner makes much of the fact that both in the original specification and in the previously submitted 131 declaration, it is disclosed that the base paper and the ink-receiving layer were known at the time of the invention. Applicants do not contend this point and remind the examiner that virtually all inventions are the new sum of parts which are old.

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10 Also in relation to the 131 declaration, the examiner objects to the fact that specific reference to the smoothness and porosity of the tradenamed base sheet is not indicated in the invention disclosure and graph submitted with the 131 declaration. Claims 1, 9 and 16 have been amended to incorporate the description from the original invention disclosure of the coated, absorptive paperbase selected from the group consisting of coated, calendered paper;

15 coated, uncalendered paper and cast coated paper. The smoothness and porosity of the base sheet is a characteristic of the coated, absorptive paperbase presently described in claim 1, which paperbase is also so described in the original invention disclosure attached to the 131 declaration. In the course of

20 preparing the application it was found by the applicants that the coated, calendered paper; the coated uncalendered paper and the cast coated paper had the smoothness and porosity number ranges set out in Table 1 of the application. These numbers, however, serve only to explain and provide limits to the description of the appropriate paper base that can be used with the

25 present invention. The fact remains that the appropriate paper base, as described in the invention disclosure, had already been combined by the applicants with the ink-receiving layer to achieve the present invention as described in the invention disclosure and the exhibits submitted with it in the 131 declaration. In light of the present amendments to the claims, an adequate

30 description is given in the claims which is consistent with the original invention disclosure submitted with the 131 declaration. This description provides evidence consistent with the fact that the inventors knew what kind of paperbase to use at the time the invention disclosure was written. On this basis it can be

- seen that the present applicants had achieved the invention and provided written evidence of the achievement of the invention before the filing of Nakano. Such written evidence established that the invention claimed in the present application was reduced to practice before March 31, 2003, the filing date of  
5 the Nakano reference, as required in 37 CFR §1.131 (c). The examiner seems to want to require that applicants provide a completely enabling disclosure of the invention in the 131 declaration such as would be required in the specification of the patent application itself. This, however, is not the requirement of the statute.
- 10 In light of the above, the fact exists that no prior art has been cited by the examiner that either predates or is contemporaneous with the present invention. No art cited shows a print medium comprising: an ink-receiving layer and a coated, absorptive paperbase, the coated, absorptive paperbase selected  
15 from the group consisting of coated, calendered paper; coated, uncalendered paper and cast coated paper; the ink-receiving layer being present on the coated paperbase from about 3 grams per square meter to about 7 grams per square meter, and the coated paperbase having a Sheffield smoothness less than approximately 20 and a Sheffield porosity less than approximately 10.
- 20 Nakano is the only reference cited by the examiner under 37 CFR 103(a) that has been cited alone against the patent application. Whether or not Nakano renders the present invention obvious under 37 CRF 103(a) is irrelevant because sufficient evidence was given by applicants that they invented and possessed the presently claimed invention before Nakano was filed in the U.S.  
25 Patent Office. Therefore Nakano is not a proper reference, and for the above reasons, the examiner is respectfully requested to accept the 131 declaration filed on June 23, 2005 with the response to the last office action.
- 30 Without Nakano as a reference, the examiner's allegations of Nakano's obviousness are moot and it is clear that no evidence has been presented of any references that can render that presently claimed invention obvious.

Without Nakano as a reference, the present 103(a) rejections with Nakano alone, or with Nakano in combination with Shih et al., Kaneko et al. or statement made in the present application or the 131 declaration cannot stand. For these reasons, applicants respectfully assert that the presently claimed invention is patentable.

In view of the above amendments and arguments, -the applicants respectfully request that the above rejections be withdrawn.

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Respectfully submitted,

Chen et al.

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